

IN THE DRAWINGS:

To overcome the Office Action's objection of the drawings, Applicants concurrently file a Submission of Formal Drawings with eleven (11) sheets of formal drawings to substitute the original filed drawing sheets. The new formal drawings amend Figs. 10 and 11 to include the label "Prior Art." Applicants respectfully request that the objection to the drawings be removed.

REMARKS**Summary of the Office Action**

In the Office Action, the drawings are objected to for certain informalities.

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,009,355 to *Akizawa et al.*, hereinafter (“*Akizawa*”).

Claims 4-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Akizawa* in view of U.S. Patent No. 5,836,502 to *Kanai, et al.*, hereinafter (“*Kanai*”).

Summary of the Response to the Office Action

Applicants propose submitting new formal drawings. Accordingly, claims 1-5 are pending for further consideration, with claim 6 being withdrawn from consideration.

Drawings

To overcome the Office Action’s objection of the drawings, Applicants concurrently file a Submission of Formal Drawings with eleven (11) sheets of formal drawings to substitute the original filed drawing sheets. The new formal drawings amend Figs. 10 and 11 to include the label “Prior Art.” Applicants respectfully request that the objection to the drawings be removed.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Akizawa*.

Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Akizawa* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that independent claim 1 recites the features of "a table, supported by a main body frame of the electric stapler, and including a clincher mechanism for folding to bend a leg portion of the staple penetrated through the sheets along the sheets, and a wing piece formed at the table." At least these features are not disclosed or taught by *Akizawa*.

Akizawa discloses an electric stapler. See the Abstract of *Akizawa*. The Office Action asserts that *Akizawa* shows "a table 4 supported by a main body frame 1 of the electric stapler, and including a clincher mechanism." However, *Akizawa* actually teaches that "[a] magazine 3 and an actuating link 4 are pivotally mounted at their first ends 4a and 3a respectively on a support shaft 2 mounted on a base 1." See Figs. 1 and 2 and col. 4, line 27-35 of *Akizawa*. In contrast to the assertions in the Office Action, *Akizawa* discloses an actuating link 4 that does not include a clincher member 38. See Figs. 1 and 6 and col. 8, lines 51-58 of *Akizawa*. According to claim 1 a clincher must be included within the table. The clincher is clearly missing from the alleged table 4 of *Akizawa*. In fact, it is the base 1 of *Akizawa* that includes the clincher member 38 and it is opposed to the driver 5a and so-called table 4. See Fig. 1 and col. 4, lines 28-48 of *Akizawa*. As such, *Akizawa* cannot anticipate the present invention.

The Office Action simply states all features are present in *Akizawa* without citing any supporting information from the reference itself. Claim language is simply recited as if the features exist in *Akizawa*. Applicants find it difficult to respond more thoroughly because these features are not specifically identified in *Akizawa*. Therefore, Applicants respectfully request that if the present rejections are maintained, the Office Action should explicitly point out where in the cited references these features are taught.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Akizawa* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2-3 are also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 4-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Akizawa* in view of *Kanai*. Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

Claims 4 and 5 depend from independent claim 1 and are allowable because *Kanai* does not make up for the above-mentioned deficiencies of *Akizawa*. *Kanai* teaches a motor driven stapler. See the Abstract of *Kanai*. *Kanai* is only relied upon to provide an eccentric cam supported by the main body frame and engaging teeth.

Applicants respectfully submit the Office Action has not established a *prima facie* case of obviousness at least because neither *Kanai* nor *Akizawa*, whether alone or in combination, teaches or suggests all the recited features of claims 4 and 5. Namely, none of the references teaches or suggests at least the “a table, supported by a main body frame of the electric stapler, and including a clincher mechanism for folding to bend a leg portion of the staple penetrated through the sheets along the sheets, and a wing piece formed at the table,” features recited in independent claim 1 from which claims 4 and 5 depend. At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Akizawa* or *Kanai*.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that at least the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection of claims 4-5 under 35 U.S.C. § 103(a) should be withdrawn because *Akizawa* and *Kanai* do not teach or suggest each and every feature of independent claim 1.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.


EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: January 23, 2007

By:


David E. Connor
Reg. No. 59,868

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001